

---

IN THE

**United States Circuit Court of Appeals**

FOR THE NINTH CIRCUIT

---

DIAMOND PATENT COMPANY (a Corporation),

Appellant,

vs.

WEBSTER BROS. (a Corporation), and C. F. MURRAY,

et al.,

Appellees.

---

**APPELLANT'S OPENING BRIEF.**

---

J. J. SCRIVNER and  
GEO. H. HARPHAM,  
Attorneys for Plaintiff.

---

The James H. Barry Co.  
San Francisco

**Filed**

AUG 21 1917

**F. D. Monckton,**  
Clerk.



IN THE  
United States Circuit Court of Appeals  
FOR THE NINTH CIRCUIT.

---

DIAMOND PATENT COMPANY	}	
(a Corporation),		
		<i>Appellant,</i>
vs.		
WEBSTER BROS. (a Corporation),	}	
and C. F. MURRAY, et al.,		
		<i>Appellees.</i>

---

APPELLANT'S OPENING BRIEF.

This suit is for the infringement of United States Letters Patent No. 801,944, issued to Fred. Weber, dated October 17th, 1905. The patent relates to show cases generally known in the market as "all-glass cemented show cases."

The improvement resides mainly in the means of fastening one glass surface to another glass surface. The object of the invention is to do away with drilling holes through the glass and to dispense with metallic or other fastening devices which were commonly used at the corners for holding the plates forming the case together and to provide a fastening which will

unite the parts so securely that they cannot be separated except by such stresses or blows as would break the glass before accomplishing the dismemberment, although by the use of a proper tool the parts may easily be separated.

Another object is to provide for a certain amount of elasticity at the joint, whereby a cushion effect is produced. If the parts were rigidly united, severe shocks received by the show-case would tend to shatter the plates or displace the parts; but in the present invention the cushion joint aids in maintaining the union of the parts, affording, as it does, an elastic or resilient joint, which eases the strain at the actual union or contact faces of the plates, thereby also greatly softening the effects of shocks received by the case.

The defendants answered and relied wholly upon the question of infringement.

## THE PROOF.

The evidence in this case is almost wholly parol, and the witnesses introduced by the plaintiff were James P. Schafer (the President of the plaintiff corporation) and Fred. Weber (the inventor and patentee).

The defendants introduced as witnesses in the case C. F. Murray, one of the defendants, and James A. Smart, an employee. The defendants also introduced several small models to illustrate their contention.

It was stipulated at the trial that the question of infringement was the only question to be tried before the Court; all other issues made by the complaint being conceded.

### THE INVENTION.

The patent and the invention therein described is very plain and in no manner difficult to comprehend. The patent has been before the Courts in many cases, and before this Court in the case of *Diamond Patent Company v. S. E. Carr* (reported in the 217 Fed. Rep., page 400).

There are two claims in the patent, which we reproduce for the convenience of the Court:

“CLAIM 1. A structure comprising a plurality of glass plates, the edges of which are spaced from the adjacent plates, a felt cushion filling the space between the adjoining plates, the plates being cemented to the felt, each plate being adapted to freely vibrate in its natural plane of vibration, and prevented by the felt cushion from imparting its vibration to the adjacent plates.

“CLAIM 2. A structure comprising a plurality of glass plates, an unconfined edge of one plate nearly but not quite meeting another plate also with unconfined adjacent edge, an elastic material filling the space thus existing between the nearest adjacent surfaces of the plates, said plates being attached to the elastic material, whereby the plates by reason of their unconfined edges and the intervening elastic material can each vibrate or move in any direction independently.”

The patent is found on page "16" of the transcript and with the description therein contained and the drawings attached to the patent, the Court cannot fail to comprehend the patent, and we think no further discussion of the invention is necessary at this time.

We might here add, however, that it appears from the record in this case that this invention has gone into very extensive use throughout the United States; that the plaintiff has licensed many manufacturers in many States, who are manufacturing and paying royalties to the plaintiff, and that, after much litigation and contention over the same, the trade has finally, almost universally, come to acquiesce in the validity of the patent; its utility and value, and they have generally ceased to attempt to infringe it.

It will be apparent from the testimony about which there is no dispute, that the two named objects of the invention mentioned in the quoted paragraphs of the patent are:

*First:* To do away with drilling holes through the glass, and to dispense with metallic or other fastening devices formerly used at the corners for holding the plates forming the case together, and to provide a fastening which will unite the parts so securely that they cannot be separated, except by such stresses or blows as would break the glass before accomplishing the dismemberment; although, by the use of a proper tool the parts may be easily separated in this patented case;

*Second:* To provide for a certain amount of elasticity at the joint, whereby a cushion effect is produced, for it is well known that if the parts are rigidly united severe shocks received by the show case would tend to shatter the plates or displace the parts.

The first claim covers a structure in which the edges of the glass plates are spaced from the adjacent plates, a felt cushion filling the space between the adjoining plates; the plates being cemented to the felt, permitting the glass plate to freely vibrate in its natural plane of vibration, without imparting such vibration to the adjacent plates, and permitting of a sufficient amount of expansion and contraction of the plates, to prevent breakage.

The second claim covers a similar structure, where the joints between the plates are made up simply with an elastic material filling the space existing between the nearest adjacent space of the plates; the plates being attached to the elastic material, whereby the plates, by reason of their unconfined edges and the intervening elastic material, can each vibrate or move in any direction independently. The result sought to be covered by the two claims of the patent are of course the same.

In plain language, the object was simply to provide a joint between the glass plates which would permit the individual glass plates to vibrate or expand or contract without affecting or communicating such expansion or contraction to the adjacent plates.

It is a well known scientific fact that glass plates do expand and contract from the effect of heat or cold, and that they may be caused to vibrate by jars, shaking of the building, and from many causes, and that where the edges are attached in an absolutely rigid manner and where there is no room or space to protect the glass from this so-called movement caused by expansion or contraction or vibration, the plates do as a matter of fact so often break that it was found to be difficult to provide means which would prevent it, and it required many years of experimenting to discover means by which this expansion and contraction and vibration could be taken up without injury to the plates themselves, and the secret of the whole thing laid in the fact that each glass must be permitted to vibrate within itself without conveying that vibration to an adjacent plate. To do this some sort of a resilient or cushion joint had to be interposed between the edges of the adjacent plates. The patentee accomplished these results by the means described and claimed in his patent. These are facts not controverted by the defendants in this case.

### ERRORS RELIED UPON.

The assignment of errors is found on pages 123-124 of the transcript. There are four errors assigned, but for the purposes of this brief they may be condensed into two. The first error assigned is based



upon the holding of the Court, during the trial, that the appellant was not entitled to an injunction, when it appeared that the defendants, since the commencement of the suit, had ceased to make the infringing cases. The other three errors relate to the dismissal of the bill, presumably for want of equity and perhaps non-infringement.

We here wish to call the attention of the Court to the fact that the Court, in dismissing the bill rendered no opinion, (oral or otherwise) and in no manner indicated the grounds upon which the bill was dismissed. This order is found on pages "16" and "17," Tr. Consequently, appellant was unable to assign any particular ground wherein the Court erred, except in the form shown by the assignments of error. We do not know whether the bill was dismissed, because the Court held during the trial that complainant was not entitled to an injunction, where it appeared that the defendants had, subsequent to the commencement of the suit, ceased to make the infringing devices (Tr., bottom page "97"). If this was the ground upon which the Court dismissed the bill, it was clearly erroneous. It is a well established proposition that, the fact that the defendants have, either before or after the commencement of the suit, ceased to make the infringing devices is no defense, and no reason why an injunction should not issue, for the reason that where a party has once committed a tort of this kind he is likely to repeat it unless re-

strained by the Court. There are instances where it appears that the defendant had in good faith ceased to infringe the patent prior to the commencement of the suit, and the Court was satisfied beyond any doubt that it was not his intention to resume such infringement; the Court might, under such circumstances, be justified in denying the injunction. But, where the defendant (as in this case) claimed to have ceased to infringe the patent months after the commencement of the suit, it is no defense and no reason why an injunction should not issue. These questions have often been before the Court and we feel sure that the Court is familiar with the rule.

See:

*Walker on Patents, Sec. 701*, and cases cited,  
especially see:

127 Fed. Rep., p. 704, at page 708.

But, however this may be, there is no pretense that either of the defendants intend to cease using the infringing devices. The Webster Bros. are only charged with using, while Murray both made and used, and is still using, without any intention of ceasing to do so.

Nor, are we informed by any action of the Court whether he dismissed the bill because infringement of either of the claims had not been established. We will discuss this question of infringement after reviewing the testimony.

## ARGUMENT.

Inasmuch as it was conceded in open court, as before stated, that the only issue in this case to be tried was that of the infringement of the patent, it is only necessary now for us to discuss that subject.

It is true that the question of infringement is largely a question of fact, but in this case we claim that, especially upon the defendants' own testimony it becomes also a question of law as well:

*Cramer vs. Singer Manufacturing Co.*, 192  
U. S. at p. 444, 48 Law Ed., 264-266.

On page "22" of the transcript appears a colloquy between the Court and counsel, which developed the contention of the parties with relation to the questions to be litigated. It there appears that the defendants admitted that they used a structure comprising a plurality of glass plates, the edges of which are spaced from the adjacent plates, but the defendants contended that they had no felt cushion filling the space between the adjoining plates, nor that the plates were cemented to the felt. They denied also that each plate was adapted to freely vibrate in its natural plain of vibration, and that the plates were prevented by the felt cushion from imparting its vibration to the adjacent plates. The Court then read the second claim, and the defendants admitted that their structure comprised a plurality of glass plates, unconfined edge of one plate nearly, but not

quite, meeting another plate, also with unconfined adjacent edge. But, the defendants denied that they used an elastic material filling the space thus existing between the nearest adjacent edges of the plates, also that the plates were attached to the elastic material whereby the plates, by reason of their unconfined edges and the intervening elastic material, each could vibrate or move in any direction independently.

In order, therefore, to establish the infringement by the defendants of the first claim, it became incumbent upon the plaintiff to show that the defendants did use a felt cushion filling, and that the plates were cemented to this felt substantially in the manner and for the purposes described in the patent. In order to prove an infringement of the second claim it was incumbent upon the plaintiff to show that the defendants used an elastic material in the space between the nearest adjacent surfaces of the plates and that said plates were attached to this elastic material substantially in the manner and for the purposes described in the patent.

The plaintiff thereupon called as its first witness, Mr. Fred. Weber (the patentee), whose testimony commenced near the top of page "24," Tr. Mr. Weber testified quite fully upon the subject, the substance of which is:

That he had had large experience in the manufacture and sale of these show cases, had been in the business about eleven years, and that he thoroughly

understood the construction and mode of operation of the patented cases; he testified further that he had examined the defendants' cases at several points in Fresno, and it was not denied that the defendants had made the cases described. He stated, that the defendants' cases which he had examined were constructed by a joint between the different plates, a layer of felt in the joints, approximately  $1/16$ th of an inch thick with cement on both sides of the felt, cemented to the plates and holding them in position, and making the joint about an eighth of an inch thick; that the joints were elastic joints, that is: they would give or allow for contraction or expansion between the different plates. He also said: that a resilient joint, as he understood it, was simply a joint that will allow for expansion and contraction. He also stated: that he had done considerable experimenting in rigid joints and that he had found that the glass would generally break on account of not being allowed to vibrate or expand or contract, on account of the heat or cold, which they received. But, with certain elastic material between the joints to take up what little vibration there may be, or expansion or contraction, this trouble is avoided.

"THE COURT—What did you do to those that  
"you examined to determine whether they were  
"resilient or had vibration?"

To which the witness answered: "I put a knife blade through the joint and cut out some of the felt." He stated that there was no other way that he knew of to determine this question. The cement was plastic; it was soft enough for a knife blade to go through the joint; that the cement used by the defendants appeared to be the same as that used by himself. He also stated (on page "27," Tr.), that the top plate was removable in the manner described in the patent.

"THE COURT—This feature is one of considerable value, inasmuch as it permits of easy removal of plate when desired, as in altering the structure of the case, or in making repairs when one or more of the glass plates become broken."

We may here remark that it is not denied that in the defendants' structure this feature existed as a fact, and that the plates could be removed in the manner described in the patent.

The witness further testified that there was no means, outside of a knife blade or pin or something of that nature to insert in the joint by which it could be determined whether it was a plastic or resilient joint or not; that if the knife blade penetrated into the joint it would show that the material was soft and plastic and therefore made the resilient or elastic joint called for in the patent, and that it acted as a sort of a cushion in the joint, so that the possible vibration of a glass plate would be protected by its resilience

or softness of the material. The witness was here cross-examined at considerable length; the main purpose seeming to be to establish that the test of inserting a knife blade in the joints was not a safe test as to whether the joint was an elastic or resilient joint, such as described in the patent.

M. James P. Schafer was then called as a witness for the plaintiff. Mr. Schafer is President of the plaintiff corporation, and has been such for the past six years. He is manager of the Diamond Show Case Company, which is a licensee of the plaintiff. Mr. Schafer has had a very wide experience in this business and is probably more familiar with the subject than any other one individual.

On pages "51," "52" and "53," Tr., Mr. Schafer fully corroborated the statements of Mr. Weber, and then went more fully into the subject of his experience and knowledge of the method of testing out the different cases to determine whether the joints were elastic or resilient and an infringement of the patent.

On page "53," Tr., Mr. Schafer said that the defendants' cases were made with a plurality of glass plates, the plates being spaced from each other with an intervening space between, with a layer of felt and a layer of plastic cement between the intervening and adjacent plates. The Court then remarked that that seemed to make a prima facie case, and the witness passed on to other subjects.

He testified that it had been his duty, as an officer



of the plaintiff, to examine all glass cases throughout the United States and to pass upon the question as to whether they were made in accordance with this patent or not, and that he had been engaged in that business ever since 1907.

On page "54," Tr., the witness testified that, in investigating these cases, "the first principle which "would apply, when we can clearly see the felt, is "to penetrate the joint with a knife, or an instru- "ment similar, to see whether the joint is elastic "enough, soft enough in there to permit the instru- "ment going through it. We cannot take the top "off in a store. Sometimes when we have a case in "our factory we could jar it, probably shake it, and "by holding our hands on the edge of the plates we "could feel the vibration of the plate, but you can't "do that in a store, so the only real means left is for "you to penetrate the joint, and I examined here in "the matter of about a dozen different stores, and I "was able to penetrate the joints in every store in "some of the cases."

The witness further testified that the only way to determine the difference between a rigid joint and a resilient joint was to penetrate the joint with a knife blade. "In my experience I found that the resilient "joints, the elastic joints, can be penetrated with a "knife blade, and in the rigid joints, solid joints, I "was not able to do that."

He also testified, on page "55," Tr., that he had



been carrying on his experiments in testing these joints ever since the first time he made a trip through the United States, along in the latter part of 1906, when he started, and had been continuously doing it ever since, making a good many trips throughout the United States and in all cities where cases were manufactured; that he had visited large manufacturers and small manufacturers and saw what they were making and putting on the market, and that he had investigated to see whether they infringed the patent or whether they did not; that he issued licenses to manufacturers and took a general survey of all the manufacturers and what they were doing in all glass cases and other cases.

He further testified that said test was a safe and reliable one, and everyone with whom he came in contact (with any knowledge at all about the cases) followed that method.

He further testified, on page "56," Tr., that he found in the rigid joint cases that they would not permit expansion and contraction of the glass, or vibration of the glass in the show case, and heavy trucks going along the street and things like that, something bumped against it, people leaning against it, knocking it, or something like that, shaking it, the hauling of trucks and things, and that they will not stand the wear and tear the elastic joint cases will.

The witness was then cross-examined at great length upon this subject; the whole of which goes to more

clearly show the witness' knowledge of the subject and that the insertion of a knife blade or other similar instrument in the joint necessarily showed that the material was sufficiently plastic and soft to give when it was pressed by the edge of the glass, by reason of expansion or contraction or vibration from jars, etc. Years of practical experience in the testing of the joints of these show cases has taught those who have had that experience that you could not penetrate the joints with a knife blade, or other similar instrument, if the joints were rigid, and that you could always do so when they were not solid or rigid, and where the joints could be penetrated in that way they meet the calls of the patent and accomplished the ends sought.

In fact, there is probably no serious denial of any of these questions by the defendants.

We insist that the testimony of these two witnesses clearly made out our case and showed an infringement of both claims of the patent.

The Court itself, at the trial, seemed to be impressed with that idea.

We will now take up the defense. The defendants offered only two witnesses, namely:

MR. C. F. MURRAY, one of the defendants;

and

MR. SMART, an employee.

Mr. Murray is a very old gentleman, probably eighty years old, pretty hard of hearing, and did not seem to have any very clear conception of the questions involved. It was apparent that Mr. Smart could talk very glibly and could tell a great many things that he did not know, even better than he could tell things that he did know. It clearly appears from Murray's evidence, on pages "82" *et seq.*, Tr., that he did, in fact, use every element covered by the first claim of the patent; that is: he had a plurality of glass plates, the edges of which were spaced from the adjacent plates, a strip of felt filling the space between the adjoining plates, the plates cemented to the felt, each plate being adapted to freely vibrate in its natural plane of vibration. But, Mr. Murray took the ground that the cement which was used and placed on the edges of the glass with a putty knife would penetrate the felt between the top layers of cement, because of its thinness, and that after it formed and set the felt and cement so mixed as to be a conglomerate mass of felt and cement and that it made a rigid joint. He admitted making the cases testified to by the plaintiff's witnesses, but said that the joints were solid joints. Being asked the purpose he had in using little strips of felt, wood or anything else, in connection with those joints, he answered: "It ain't necessary at all. We can use heavier cement, leave everything out, the felt or anything else out. It is not necessary at all."

Being asked, what the felt would do when he made them in that way, he answered:

"If we put it on that way, it would simply keep it so the cement won't be forced out, clear down, if we put in anything at all. In using that thin cement you had to put something in so it would not force the cement all out. We wanted some of it left there, sure. The only purpose in using felt or anything else in there, was because of the unevenness of the plane, and the cement was so thin that when it was put on alone it would 'squash' clear out, if it was not put in there; that was the only purpose of it. I never found any trouble with rigid joints; I never had any objection to them. I now use a more viscous or harder cement, and don't use any other material than the cement itself. I never bought any cement of Mr. Schafer or Mr. Weber for that purpose. I don't use theirs. We did make it ourselves for awhile. I never made an all-glass show case with the cushion or resilient joint."

On cross-examination Murray testified, on page "84," Tr., that he knew pretty near how the Weber case was made; that he made them with cement, just as he described in his application; he puts the cement on both sides of the felt and lays the felt between the plates. It makes a cushion joint; *"I mean by cushion joint that the cement don't penetrate, don't meet in the center, leaves fiber in there."*

Being asked what was the effect of that on the glass plate, he said: "I don't know; no particular effect at all; I don't think." Being asked, if there was any

difference in his mind between a rigid joint and a resilient joint, he said: "It don't amount to a snap of your fingers."

Being further asked, if (in his opinion) there was any difference in the effect or purpose of having a plastic, resilient joint, or a solid, rigid joint, he answered: "I can't see how it would make any difference."

"Q. Then the idea, according to your information, of putting felt in the cement at all is useless?

"A. Yes, I think so."

Let it be remembered that the witness had already testified that by the use of the felt, as described, a cushion joint was made, where the cement did not penetrate the felt, etc.

The witness then, on page "85," Tr., went on to describe how he had made the cases in the Webster Store as an illustration of how he had been making them up to several months subsequent to the commencement of this suit. He said: "We put on first "a layer of cement on the edge of the plate, piled up "in a cone shape, and then put on a layer of thin "felt on the top of this cone shaped cement and then "a layer of cement on the top of the felt, and then "pressed it down." He also stated that this cement "was a soft, plastic material, I think." Being asked, if the cement was soft and plastic, if it would not tend to make a cushion, he answered:

"A. No sir, you can't do it."

His contention being, that it made an absolute rigid joint. The whole contention of Mr. Murray being simply, that in his case the plastic cement penetrated the felt and made a rigid joint, while the plastic cement used in the case of the patented show case did not penetrate the felt and made a cushion joint. Of course, we contend that this is a mere attempt at evasion of the claims of the patent and should not be considered at all.

This testimony of Mr. Murray clearly shows that he did not have any very intelligent conception of the difference between a rigid and a soft plastic or cushion joint, nor the subject of the expansion and contraction of the glass plates. It is too late now in the art of glass show cases for anyone to undertake to contend that there is no difference between the resilient joint and a rigid joint, and that these glass plates, if the joints are solid and rigid, and have no other means provided to allow the plates to expand or contract from the effects of heat or cold, or to vibrate from jars, etc., are not proper joints to use, or that there is no difference between such joints and the elastic joints called for in the patent. The difference is well recognized by every intelligent manufacturer, and it is well known that rigid joint show cases have practically ceased to exist. It is significant, however, that some months after this suit was commenced, and before the trial, Mr. Murray had ceased for the time being to use felt and was making his joints out of

purely a plastic cement, thus avoiding the first claim of the patent, but infringing the second claim, which covers a resilient joint made from a plastic material alone.

The other witness called by the defendants was James A. Smart (his testimony commencing on the bottom of page "89," Tr.). It might as well be understood at the beginning of our comment on the testimony of this witness, that it appears from his own testimony (which was undoubtedly correct) that he had no knowledge of what the Murray people were doing, or how they made their cases prior to about two months before the trial of the case. He was a former resident of Los Angeles and came up to Fresno and became Manager of the defendant, The Murray Show Case Company, about July 1st, preceding the trial of the case. He had worked for the Weber Company in Los Angeles for some six years and was entirely familiar with the construction of the Weber Show Case. He proceeded to describe the method of constructing the Weber show case, and upon being asked by Mr. Gallaher, on page "91," Tr., to explain what the construction of the show case was, *then* being manufactured by the Murray Show Case Company, he answered:

"A. It makes a solid joint.

"Q. Well, explain how it is composed?

"A. Composed of cement. In fact, they were using a real thin felt until I came up here, and I told them not to use any felt at all, to use nothing



but cement, because a rigid joint of cement is just as good as felt would be.

"Q. Can you say whether or not in the manufacture of their (the defendants') cases the cement permeated the felt?

"A. Yes, sir, we endeavored to make a thin cement."

But, it will be remembered that Mr. Smart was not there and never saw the defendant Murray making any of the cases that he had made prior to the commencement of this suit.

The witness was then cross-examined and the character of his testimony clearly indicates that he did not know what he was testifying about, and that he was disposed to evade the truth.

The first question asked him (p. "92", Tr.), was:

"Q. What cases here in town do you know that the defendant Murray made?

"A. Made the cases for the Owl Drug Store. They are made with solid joints; made with cement, not felt in the joints. *I never saw the Murray Company make any cases before I came up here.* We put on the cement with a putty knife, on the upper edge of the plate. We put a piece of felt on the top of the cement, and on the top of that another layer of cement that penetrates it.

"Q. How do you know that it penetrates?

"A. Because I can take a putty knife and penetrate it. We tried it.

"THE COURT—I thought you said awhile ago you didn't put any felt in there. (Here is a plain prevarication.)

"A. I did, on these samples, yes, sir. I made these samples and we did, but we manufactured



it in Los Angeles. We can penetrate the felt with a putty knife.

"THE COURT—He is asking you what you did here.

"A. We use nothing but the cement now, since I have been here.

"Q. Since the suit was commenced you changed the program?

"A. Since I came up here. *I don't know anything about when the suit was commenced.* My testimony, so far as the manufacture of these show cases are concerned, only goes to that period of time, since July this year. I know nothing about what occurred prior to that time. I don't know how they were built, or what the effect was, whether solid or elastic joints."

This testimony leaves a question, as to how the defendant made the joints prior to the time when Smart arrived and induced Murray to make the changes mentioned, by the omission of the felt, entirely between the two witnesses for the plaintiff (Weber, the inventor, and Shaffer, the president of the company) on one side, and Mr. Murray on the other side. There is no dispute but that all the cases made by the defendant Murray prior to Smart's time were made by the use of felt in the joints. The only question is, as to whether the plaintiff's witnesses were correct in designating them as elastic joints as called for by the patent.

As already shown, Mr. Murray's testimony is entirely insufficient to overcome the testimony of experienced witnesses, such as we produced. The wit-

ness was then taken up again on re-direct examination and testified with relation to some models that he had made, which we cannot see are of any value.

On re-cross examination, page "95," Tr., the witness testified, that the way the defendant Murray made the cases *now was*, he did not use any felt at all.

"Q. What sort of cushion do you make?

"A. Thick cement.

"Q. Plastic?

"A. I don't know what the word means.

"Q. Soft?

"A. Yes, soft, pliable.

"Q. It gives, yields?

"A. Yes, sir.

"Q. Has that got any felt in it?

"A. No, sir.

"Q. No felt ground up and made in it?

"A. I didn't make it.

"Q. Do you know where you get it?

"A. Yes, sir.

"Q. You don't know how it is made?

"A. No, sir."

This testimony bears altogether upon the second claim of the patent and, if it is correct, it would show an infringement of that claim at this time.

At the bottom of page "97," Tr., the Court said: "That second claim comes up in the proposition. As near as I remember you said: they claim they are not doing it now. You couldn't have an injunction if you don't prove they are now doing it."

Here, we think the Court laid down a rule of law that is entirely untenable and incorrect. How far it

may have influenced his final Order dismissing the bill we are unable to say.

The witness here entered into some discussion as to the characteristics of the joints made by the cement alone, but when asked on page "99," Tr.:

"Q. How was it in the joint?

"A. I didn't test it in the joints.

"Q. Did you ever try to put your knife through one of these joints that you made, that you call solid?

"A. Yes, sir.

"Q. Can you do it?

"A. Yes, sir.

"Q. Then that material will give?

"A. Pushes the material out, the knife does. You can shove a knife through."

Here the witness gave some testimony in answer to questions by the Court, as to the condition of the joints in the Owl Drug Store cases. But this case was made long after the suit was commenced and is not in issue, nor was it put in issue by the plaintiff. At this point, the Court with counsel and the witnesses visited several of the places where show cases had been made and installed by the defendants prior to the commencement of the suit. The testimony is not particularly illuminating and only goes to show that, where the joints were made as testified to by the plaintiff's witnesses and by Mr. Murray also, that the knife blade could be readily introduced into the joints, and that they were such joints as described in the patent.

On page "116," Tr., Mr. Shaffer having been recalled for further examination, after the conclusion of the examination of the cases by the Court, testified in regard to the cement used in the Owl Drug Company cases. In that instance, it will be remembered, no felt was used.

Being shown the Court's Exhibit A, he was asked to look at it and state if he knew what it was.

"A. That is a piece of cement, removed from one of the joints of the Owl Drug Company's case.

"Q. Now is that, in your opinion, a yielding or resilient substance?

"A. Yes sir.

"Q. Which is termed in the second claim as an elastic material?

"A. Yes, sir.

"Q. Well, now tell how that operates, how it does, in fact, operate in the device.

"A. It acts as a cushion in the chain to prevent the shocks of the plates communicated from one to another, and to permit of expansion and contraction of the plates.

"MR. SCRIVNER—Now, as a matter of fact, can, if necessary, the plates constituting the top and the sides of the case, by reason of their unconfined edges, held apart by this stuff, the Court's Exhibit A, and the intervening plastic material you have been shown, in the middle. can these plates vibrate or move in any direction, independently? No difference how small or how great, can one move independently without transmitting its movement to the other plate?

"A. Yes, sir.

"Q. Upon what do you base that conclusion?

"A. I base it on the fact, one fact, that the

showcase will stand the ordinary use put to in stores, and the different climatic conditions it is subjected to, which make vibration or expansion or contraction, and the plate will expand or contract. It may be a very small part, and may need a very fine instrument to record the amount of movement there is in there.

"Q. Mr. Shaffer, I will ask you, whether there is any other reason that you know and can state to the court why this stuff you have got there makes an elastic joint?

"A. It makes an elastic joint for the reason that it is plastic.

"Q. In your opinion, does the words 'elastic material' mentioned in claim two contemplate that yielding or resilient substance other than felt, referred to in the second claim of the first page of the patent?

"A. Yes."

On page "118," Tr., Mr. Murray was recalled and testified that he had employed Smart about six months ago; that he had made some changes in making his devices since Smart came up; that since Smart came up he had made some cases as he had described in his previous testimony.

"Q. You have not ceased permanently to make them that way, have you?

"A. No.

"Q. And you make them both ways now?

"A. What do you mean by 'both ways'?

"Q. With felt and without felt.

"A. Yes.

"Q. Do you expect to continue to do so?

"A. Yes.

"Q. Now why have you ceased to make them

all with felt in the joints—some without felt in the joints? In other words, why do you make them without felt in the joints at all?

“A. Because I think it is the best way to make them.”

At the request of the Court, Mr. Smart was recalled for further examination.

“THE COURT—This substance in the showcases at the Owl Drug Store, do you claim that will get hard?

“A. Yes, sir.

“Q. How long will it take to get hard?

“A. Well, where it is squeezed out to a thin layer, where the glass fits close enough together, as it should be, it will get hard in say about three months, two months—three months—all depends on the heat or the cold, of the weather. In cold weather I would say it would take longer. Where it is thick, for instance, where the cases come apart, the instance over there in particular, we cemented the cases one night and delivered them next morning. They were absolutely fresh, they were in a hurry for them, and we had to go over there and shove in some cement, without taking the cases apart, filled it in with a putty knife, to hold it until we got a chance to go down some night and do it at night. That is the condition of the case we saw.”

On cross-examination, page “121,” Tr., he was asked how long he had been actually making these cases, where nothing but the cement was used.

“A. I have only been making them practically since I came up here.

“Q. When was that?

“A. About two months ago, I should judge.

"Q. Is that hard and brittle?

"A. Some of them are.

"Q. Well, that one at the drug store?

"A. That one that we took the cement out of—no, because it is fresh.

"Q. How do you know how long it will take that particular case, for the joint to get hard and brittle?

"A. I can't say how long it would take that particular case.

"Q. Now name one particular case here in Fresno where the material has become absolutely hard and brittle?

"A. I don't know as there is any hard and brittle, absolutely, that I made.

"Q. Well, that is what we are talking about, what you made. You said those you made got hard and brittle.

"A. Yes, they do.

"Q. Well, where is one of them?

"A. They are not here. You asked me when I made them up here.

"Q. Yes, and I asked you where one was, where we could go and see it?

"A. You can see them down at Los Angeles.

"Q. None of them you have made up here in six months are hard and brittle?

"A. I have not been here six months.

"Q. Well, in three months?

"A. I have only made them 2 months.

"Q. They have not become hard and brittle yet?

"A. No, sir."

Now, the sum and substance of Mr. Smart's testimony is, that after he came up he advised Mr. Murray to cease inserting the felt in the joints and that he



mainly did so. That Smart, as a workman, made a number of cases without any felt in them, within about two months prior to the trial; that the joints in none of them, so made, had become hard and brittle. Consequently, there is no reliable evidence before the Court that any of the cases charged to have been made by the defendants, by Smart, had become hard and brittle. In fact, there is no reliable evidence that the joints in any of the cases made by defendant had become hard and brittle.

It seems that the two witnesses for the defendants did their best in an effort to evade the provisions of this patent and yet get all of its benefits. Probably they did not make as good cases, or as good reliable joints as the plaintiff makes, but they took all of the elements and features of the patent and combined them in exactly the same way and, undoubtedly, got the same results, or substantially the same results, and should be held as infringers of this patent.

It must be remembered that neither Murray or Smart ever tested any of these joints with a knife blade, or any other instrument, or at all. By actual experience they know nothing whatever of such tests, or what they would show. Neither of them knows whether the joints in the defendants' cases were solid or soft and elastic.



## INFRINGEMENT.

This patent has been before this Court several years ago, in the case entitled the "*Diamond Patent Company vs. S. E. Carr Company*," and is reported in 217 Fed. Rep., at page 400. In that case the only question submitted to the Court was as to the validity of the patent. It was claimed that it was anticipated and that was the only question of fact submitted. In this case the only question is one of infringement; the validity of the patent being conceded.

The character of the testimony for the defense does not materially differ from the ordinary stock testimony usually produced by defendants who are attempting to evade a patent and yet retain the substantial benefit thereof. The defendant will, no doubt, claim that there is some conflict in the testimony in regard to the question of the infringement and that, therefore, this Court will not interfere. We maintain, however, that there is no substantial conflict and we think that it will be apparent from reading the testimony of Mr. Murray himself. If, however, there is any slight conflict still that is not at all conclusive.

In the case of *Wilson & Willard Manufacturing Company vs. Bole* (227 Fed. Rep., page 610) this Court, in an opinion written by Judge Rudkin, said:

"The fact that the trial court decreed in favor of the appellees on conflicting testimony is entitled to consideration; but, if this court is convinced that

the decree is erroneous, after giving due weight and consideration to the superior advantages possessed by the trial court, a reversal must follow."

This is a well-known rule, and we do not think it worth while to cite other cases. This rule is particularly applicable to this case, provided it can be fairly said that there was any shadow of conflicting testimony in the record. As we have already shown in reviewing the testimony, the only evidence in the record on the part of the defense, as to what the defendant Murray did, prior to the commencement of the suit, was given by Mr. Murray, and while he concedes the use of all the elements of the first claim and in fact the elements of the second claim as well, he claims that the joints in the showcase were rigid instead of being elastic or resilient. He, however, gives no reason whatever for his conclusion that his joints were rigid. He does not pretend to ever have made any examination or test to determine that question. It is simply a bald statement that the joints are rigid, without the slightest testimony of any kind to support that statement, and we claim that such a statement cannot be held to conflict with the careful investigations made by plaintiff's witnesses and their intelligent statements and opinions based upon long experience in these matters.

As it has been well said in a number of decisions:

"The mere fact that there is an addition, or the mere fact that there is an omission, does not enable

you to take the substance of the plaintiff's patent. The question is not whether the addition is material or whether the omission is material, but whether what has been taken is the substance of the invention."

115 Fed., 504;

81 Fed., 395;

92 Fed., 653;

97 U. S., 120;

24 L. Ed., 935;

117 U. S., 689;

29 L. Ed., 1017.

We cannot see how the defendants can escape the charge of infringement of the first claim. They attempt to make it appear that they used a thin piece of felt, and that being thin rather than thick it necessarily absorbed the cement and thereby became a conglomerate mass, which he claims *of necessity* became solid. Smart admits in his testimony that he did not know anything about how the cases made by Murray before he came to Fresno were constructed, what the results were, or whether the joints were rigid or elastic. This clearly appears in Smart's cross-examination on page "121," Tr.

It must be remembered that the cases (often mentioned as The Owl Drug Store cases) were made long after this suit was commenced and after Smart came to Fresno, and it appears that the joints are not hard in those cases yet, but Mr. Smart gives it as his opin-

ion, that the joints in those cases will get hard in from two to three months, or more, owing to the weather. Of course, that is a mere speculation and of no value.

In his cross-examination on page "121" he said:

"I have only been making them practically since I came up here.

"Q. When was that?

"A. About two months ago, I should judge.

"Q. Is that hard and brittle?

"A. Some of them are.

"Q. Well, that one at the drug store?

"A. That one that we took the cement out of—no, because it is fresh.

"Q. How do you know how long it will take that particular case, for the joint to get hard and brittle?

"A. I can't say how long it would take that particular case.

"Q. Now name one particular case here in Fresno where the material has become absolutely hard and brittle?

"A. I don't know as there is any hard and brittle, absolutely, that I made.

"Q. Well, that is what we are talking about, what you made. You said those you made got hard and brittle.

"A. Yes, they do.

"Q. Well, where is one of them?

"A. They are not here. You asked me when I made them up here.

"Q. Yes, and I asked you where one was, where we could go and see it?

"A. You can see them down at Los Angeles.

"Q. None of them you have made up here in six months are hard and brittle?

"A. I have not been here six months.

"Q. Well, in three months?

"A. I have only made them 2 months.

"Q. They have not become hard and brittle yet?

"A. No, sir."

As to the second claim, we contend that the testimony of Mr. Smart himself clearly shows that the joints, made with the cement used by the defendant, made an elastic joint. Our experimental tests showed that fact and our witnesses so stated and neither Smart nor Mr. Murray showed or testified that in any of those cases, made in that manner, the joints had become solid and rigid. Consequently, we urge that both claims are clearly shown to have been infringed, and that the decree entered dismissing the Bill is clearly erroneous, and we respectfully request the Court to reverse the decision of the Court below and order a decree in favor of the plaintiff.

All of which is respectfully submitted.

*J. J. Scriven &  
Geo. H. Harpham*

Attorneys for Plaintiff.

